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Paper No.

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re DiLegge

Serial No. 75/425,118

Jamie J. Fitzgerald of Cummings & Lockwood for William DiLegge.

Jennifer D. Richard, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Simms, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

William DiLegge has filed an application to register the mark "PASTA COSI" for "pasta sauces, namely, tomato-based sauces."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to his goods, so resembles

¹ Ser. No. 75/425,118, filed on January 28, 1998, which alleges a bona fide intention to use the mark in commerce. The word "COSI" means "LIKE THIS" in English and the term "PASTA" is disclaimed.

the mark "COSI," which is registered for "restaurant services,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Turning first to consideration of the respective goods and services, it is well settled that that the issue of likelihood of confusion must be determined on the basis of the goods and services as they are set forth in the involved application and cited registration. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the goods and services in the application at issue and in the cited registration are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registration encompass not only all goods and services of the nature and type described therein, but that the identified goods and services move in all channels of

² Reg. No. 2,046,483, issued on March 18, 1997, which sets forth dates of first use of February 17, 1996. The word "COSI" means "LIKE THIS" in English.

trade which would be normal for such goods and services and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Applicant, contrary to the above, contends that his "PASTA COSI sauce is intended for home use" and would be "sold in supermarkets and food stores," while registrant's "COSI sandwich shops do not in fact sell sauces and never have."³ According to applicant, "COSI is not even an Italian restaurant, nor, more to the point, are its services identified as such in its registration." Instead, and notably without any evidentiary support, applicant asserts that "COSI is simply the name of a very small restaurant chain" and, because "[t]he Examiner has offered no proof that COSI restaurant is any more likely to sell spaghetti sauces than Burger King is," insists that "[t]he channels of trade are different, [and] the customers are different." However, why customers for applicant's tomato-based pasta sauces would not also have occasion to patronize registrant's restaurant services is never explained.

Applicant, although again without citation to relevant authority, is nevertheless on firmer ground in arguing that there is no *per se* rule that all food products

³ Presumably, applicant bases such argument on the fact that the owner of the cited registration is listed as "Wainwright Sandwich Partners."

and restaurant services are related for purposes of determining whether contemporaneous use of marks respectively associated therewith is likely to cause confusion. As our principal reviewing court has held in *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982), "[t]o establish likelihood of confusion a party must show something more than that similar or even identical marks are used for food products and for restaurant services." Here, notwithstanding the evidence (discussed below) made of record by the Examining Attorney in support of her position, applicant "disputes the Examining Attorney's argument that because *some* restaurants may sell their own private label food products, *all* food products are therefore 'related' to all restaurant services for purposes of the likelihood of confusion analysis."

Specifically, applicant urges that "[t]he Examining Attorney's scanty evidence does not warrant leaping to the conclusion that 'consumers familiar with registrant's COSI restaurant services would be likely to conclude, upon seeing applicant's PASTA COSI pasta sauce in a grocery store, that the pasta sauce was manufactured or sponsored by the registrant.'" According to applicant:

This is not only rigidly academic, but implausible. There are relatively few consumers familiar with registrant's localized operations.

Applicant readily admits that there are some famous restaurant marks, e.g., McDonald's to Lutèce, from Hard Rock Café to Zabar's, that are used in connection with many types of food and restaurant products and services and even other merchandise. Applicant further concedes that because those marks are strong, the use of a highly similar mark on most types of food products would cause confusion. However, COSI is not such a mark, and the Examining Attorney has offered no proof that it is. PASTA COSI is different from COSI. The relevant consumers would neither recognize nor expect that either mark is used in connection with both restaurants and sauces.

As the Examining Attorney correctly observes, the issue of likelihood of confusion must be determined in part by whether applicant's tomato-based pasta sauces are related in a commercial sense to the "restaurant services" identified in registrant's registration, an identification which necessarily includes Italian restaurant services. Here, the Examining Attorney has made of record 15 use-based third-party registrations of marks which are registered for "pasta sauces," "Italian sauces," "tomato sauces" or other "sauces" (which would include tomato-based pasta sauces) on the one hand and "restaurant services" on the other. Four of such registrations, in fact, plainly encompass both tomato-based pasta sauces and Italian restaurant services. Although the

third-party registrations are admittedly not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods and services listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

In addition, the Examining Attorney has made of record excerpts from newspapers and magazine articles which, as pointed out by the Examining Attorney, "demonstrate a trend for restaurants to offer or license food items bearing their restaurant mark for sale in grocery stores." Such evidence, we further note, indicates that the opposite is also occurring in that producers of food products are expanding to open restaurants under the same marks as utilized in connection with their food items. The following examples are representative:

"Some confused shoppers wheeling down supermarket aisles might mistakenly think they're at their favorite chain restaurant.

Big chains from Taco Bell to Starbucks are virtually lining up to license their names for products sold at the grocery store.

With a wave of consumer interest in familiar brand names, restaurant chains could amass more than \$1 billion in additional revenue within three years, simply by licensing their brand names to

everything from ice cream to salsa makers, projects restaurant industry consultant Ron Paul." -- USA TODAY, undated (article headlined: "Restaurant brands fill supermarkets");

"The supermarket display case, once the preserve of just a few branded restaurant products, has exploded as dozens of restaurant chains fill the shopping aisles with food from their menus.

....

Just nine months into a test market program ..., Taco Bell has ... penetrate[d] more than 2,000 supermarkets--mainly in the Midwest and South--with its branded line of salsa, taco sauce, taco shells, refried beans and other products. In most of the test markets where the test is under way, Taco Bell is the No. 1 label in the Mexican foods and snack category, spokesmen said.

....

Once viewed as a gimmicky out-of-field marketing opportunity tht [sic] was long associated with White Castle hamburgers or the steak sauce of Lawrys The Prime Rib steak house, the placement of signature menu items by restaurants has become a thriving enterprise for Chi-Chi's, Friendly's, Cucina! Cucina!, Chicago Brothers Pizza, Marie Callender, T.G.I. Friday's[,] Sonny's Barbecue, Bennigan's, Skyline Chili, Bob Evans and Nathan's Famous.

....

Foodservice operators aren't alone in their efforts to cross-merchandise their product. Branded consumer foods suppliers are taking what is for them a non-traditional route to diversify their revenue streams by opening restaurants.

In the Atlanta Airport, for example, a year ago Oscar Mayer launched a prototype of a foodservice outlet it intends to license nationwide, featuring its weiners [sic] and other products.

More recently, the Monterey Pasta Co., a popular fresh-pasta label in West Coast

supermarkets, is opening mall-based restaurants. Both efforts came years after Haagen-Dazs and Ben and Jerry's ice-cream manufacturers branded out with restaurants." -- Nation's Restaurant News, November 15, 1993;

"Consumers now can have their 'celebration of food' at home with new Chi-Chi Restaurant Style San Antonio Chile. Retailing for \$1.79 in supermarkets nationwide are 15-oz. cans." -- New Product News, October 12, 1993; and

"Tumbleweed Chile Con Queso, cheese dip from Tumbleweed restaurants that sells for about \$2.80 in supermarkets." -- Courier-Journal, April 24, 1989.

Clearly, rather than constituting what applicant dubs "scanty evidence," the above proof is more than sufficient to show the requisite "something more" between tomato-based pasta sauces and restaurant services, including in particular Italian restaurants. See, e.g., *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209, 1211 (TTAB 1999). We consequently concur with the Examining Attorney that the respective goods and services are so closely related that, if marketed under the same or similar marks, confusion as to their source or sponsorship would be likely to occur.⁴

⁴ As the Examining Attorney accurately notes in her brief:

It has often been held that food products and restaurant services are closely related. *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988) ... (likelihood of confusion between MUCKY DUCK with duck design used on mustard and MUCKY DUCK with duck design used on restaurant services); *In re Appetitio Provisions*

Turning, therefore, to consideration of the marks at issue, applicant argues that while the marks "PASTA COSI" and "COSI, when considered in their entireties," "overlap in the word COSI, ... that alone does not give rise to a *per se* likelihood of confusion" and that, overall, such marks "create sufficiently different commercial impressions ... so that there is no likelihood of confusion." According to applicant, "[t]he fact that the word PASTA is disclaimed does not render it invisible"; rather, the presence thereof in applicant's mark "creates a strong impression, such that the overall

Co. Inc., 3 USPQ2d 1553 (TTAB 1987) (likelihood of confusion between APPETITO and design used on [I]talian sausage and A APPETITO'S with sandwich design used on restaurant services); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984) (likelihood of confusion between BEEFMASTER used on restaurant services and BEEF MASTER used on frankfurters and bologna); *Roush Bakery Products Co. Inc. v. Ridlin*, 190 USPQ 445 (TTAB 1976) (likelihood of confusion between HILLBILLY and design used on bread and HILLBILLY RESTAURANT used on restaurant services); ... *In re Three Chefs Corp.*, 175 USPQ 177 (TTAB 1972) (likelihood of confusion between IT'S WISHBONE SWEET used on restaurant and carryout food services and WISHBONE used on frozen poultry); *The Dog House, Inc. v. The Dawg House, Inc.*, 138 USPQ 466 (TTAB 1963) (likelihood of confusion between THE DOG HOUSE and design used on restaurant services and DAWG HOUSE used on food products); [and] *Arnold Baker's, Inc. v. Food Catering, Inc.*, 123 USPQ 511 (TTAB 1959) (likelihood of confusion between THE BRICK OVEN and design used on restaurant services and BRICK OVEN or BRICKOVEN and design used on cookies and other baked goods).

significance of the mark as a whole is distinct from that of [registrant's mark] COSI."⁵

⁵ In his brief, applicant additionally raises the argument that (*italics in original*):

COSI is also registered under No. 1,553,918 [sic] to Nestle SA for "coffee and coffee extracts; coffee substitutes and extracts of coffee substitutes" ... since 1989. If Nestle's COSI ... did not bar the registration of COSI (the cited mark) for restaurant services ... a decade latter, why should the registration ... now bar the registration of PASTA COSI? Applicant recognizes that the Examining Attorney is not bound by the vagaries of prior registration decisions. On the other hand, surely an applicant is entitled to rely on a certain degree of consistency in decisions to register.

Coffee is invariably served in any sort of establishment serving meals, yet the Commissioner had no problem registering the cited COSI for restaurant services in coexistence with the senior registration of COSI for coffee. It therefore seems rather punitive and arbitrary to now take the position that a mark as different as PASTA COSI, for which registration is sought only for pasta sauces ..., may not join the field.

While applicant also makes the statement, for which there is no proof of record, that the mark "COSITA was recently allowed for use on canned, jarred and frozen fruits and vegetables" by another third party, the Examining Attorney dismisses applicant's reliance "on the purported existence of third[-]party registrations" by noting that, "[s]ince copies were not provided, these registrations are not part of the record and have not been considered." However, the existence of the Nestle registration (which is actually Reg. No. 1,552,918), like that of the cited registration, was noted by applicant in the application as filed, along with a statement that applicant believes that his mark "is registrable over Reg. Nos.: 1,552,918 and 2,046,483, because there is no likelihood of confusion" Consequently, as to the Nestle registration, the Examining Attorney should have treated the fact of the existence thereof as being of record. Nevertheless, we are not persuaded by applicant's argument with respect thereto since, while consistency of examination is certainly desirable, it is still the case that the existence of third-party registrations of the same or similar marks has little weight on the question as to whether the marks at issue, when viewed as a whole, are confusingly similar in light of the respective goods and services. The existence of third-party registrations for the

The Examining Attorney, on the other hand, tellingly notes that "applicant has not pointed to any specific difference in meaning caused by the addition of the descriptive term PASTA" to the word "COSI" in applicant's mark. Thus, the Examining Attorney maintains that "the mere addition of the word PASTA to the registered mark COSI does not serve to obviate the likelihood of confusion caused by the applicant's mark PASTA COSI."

We agree with the Examining Attorney that, when considered in their entirety, the marks "PASTA COSI" and "COSI" are substantially similar in sound, appearance, connotation and commercial impression, given the shared term "COSI" and that the sole difference is the addition of the descriptive term "PASTA" in applicant's mark. While, as we have done, the respective marks must be compared in their entirety, it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their

same or similar marks is not evidence of what happens in marketplace or that customers are familiar with their use. In short, "the existence of confusingly similar marks already on the register will not aid an applicant to register another confusingly similar mark."

entireties." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" 224 USPQ at 751.

Here, as noted above, because the dominant and distinguishing element of applicant's "PASTA COSI" mark, due to the descriptiveness of the term "PASTA" for tomato-based pasta sauces, is the arbitrary word "COSI," which is identical to registrant's "COSI" mark and is likewise arbitrary for restaurant services, the respective marks as a whole engender substantially the same commercial impression. Accordingly, we conclude that purchasers and prospective customers, familiar with registrant's "COSI" mark for "restaurant services," would be likely to believe, upon encountering applicant's substantially similar "PASTA COSI" mark for "pasta sauces, namely, tomato-based sauces," that such closely related services and goods emanate from, or are otherwise sponsored by or affiliated with, the same source. See, e.g., In re Azteca Restaurant Enterprises Inc., supra at 1212-13. In particular, and even if such consumers were to notice the difference in the marks, in that applicant's mark includes the word "PASTA,"

Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406,

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they would still be likely to view applicant's "PASTA COSI" tomato-based pasta sauces as a new product line from the same source as the operators of registrant's "COSI" restaurants.

Decision: The refusal under Section 2(d) is affirmed.

R. L. Simms

T. J. Quinn

G. D. Hohein
Administrative Trademark
Judges,
Trademark Trial and Appeal
Board